

REMARKS

Status of the Application

Claims 1 and 4 are pending in the instant application.

In order to further business interests and without acquiescing to any of the arguments raised by the Examiner while expressly reserving the right to prosecute the same claims as originally filed (or claims similar thereto) in subsequent application(s); the Applicants have amended claims 1 and 4. Specifically, claims 1 and 4 have been amended by further defining the "bifunctional linker arm." Support for this amendment is provided by the chemical structures of "bifunctional linker arms" set out in Table 1, 2, and 3, on page 16-17, 18 and 19, and Figures 1A, 1B, 2A, 2B, 3, 4, and 5 in the application as filed. These amendments introduce no new matter.

Claims 1 and 4 have been rejected on the following grounds:

1. Claims 1 and 4 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1 and 4 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent 6,255,476 to Vinayak *et al.*

The Applicants believe the present amendments and the following remarks traverse the Examiner's rejection of the claims. These remarks are presented in the same order as they appear above.

1. The Claims Satisfy 35 U.S.C. §112, First Paragraph

The Applicants hereby renew all their previous arguments rebutting the rejections of the claims under 35 U.S.C. §112 (first paragraph). In particular, the Applicants note they have described (in Tables 1, 2, and 3) a representative number of species of bifunctional linker arms by their complete structure. Moreover, the Applicants state that:

“As used herein, the term “bifunctional linker” and “bifunctional linker arm” refer to a compound that *can link two additional compounds together by chemically interacting with both of them simultaneously*. In the present invention, one example of a suitable linker is a phosphoramidite. In the present invention, for example, a bifunctional linker arm is where one functional group is suitable for coupling with the 5' hydroxyl group of an oligonucleotide and the second functional group is suitable for coupling with an available functionality on the label compound.”¹ (Emphasis added)

More specifically, in the General Description section, the Applicants teach that:

“Following the activation of the carboxyl functional group, the tetramethylrhodamine is reacted with a bifunctional linker arm Such a linker arm serves several functions. It *provides needed distance between the label and the oligonucleotide*, a functional group, in this case an amine; appropriate for reaction with the tetramethylrhodamine and a functional group, in this case a hydroxyl, which will ultimately allow for the coupling to the 5' hydroxyl of a support-bound protected oligonucleotide.”² (Emphasis added)

The Applicants, therefore, provide a nexus between the comprehensive list of specific compounds which may serve as a bifunctional linker arm and the functional attributes of the same. The Applicants submit, therefore, the claims set out in the Applicants' Response to the Office Action mailed November 15, 2004 satisfy the written description requirement of 35 U.S.C. §112 (first paragraph).

However, in order to advance business interests and without acquiescing to the Examiner's arguments (while expressly reserving the right to prosecute the claims as filed or claims similar thereto), the Applicants have amended the pending claims by claiming a bifunctional linker arm in view of a closed group of compounds. The Applicants respectfully submit the pending rejection under 35 U.S.C. §112 (first paragraph) is moot and should, therefore, be withdrawn.

¹ Page 8, ll. 5-11, ¶ 32 of the application filed on June 28, 2001.

² Page 11, ll. 15-24, ¶ 51 of the application filed on June 28, 2001.

2. The Art Rejection Is Moot

In order to advance business interests and without acquiescing to any of the arguments offered by the Examiner while expressly reserving the right to prosecute the claims as originally filed (or, claims similar thereto) the Applicants have amended pending claims 1 and 4. Specifically, the Applicants have reintroduced the closed group of bifunctional linker arms that was originally entered through the Applicants' Response filed on March 31, 2003. The Applicants note that, in view of the amendment entered through the Response filed on March 31, 2003, the Examiner withdrew the (then) pending rejection under 35 U.S.C. §112(e) in view of U.S. Patent 6,255,476 to Vinayak *et al.*. Given that the Examiner has already acknowledged that such claims are not anticipated by Vinayak *et al.* the Applicants respectfully request the pending rejection under 35 U.S.C. §112(e) be withdrawn.³

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' claims as amended should be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourages the Examiner to call the undersigned collect at (617) 252-3353.

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³ Since the Examiner did not renew, in the Office Action mailed 06/29/05, any of the Obviousness rejections previously raised; the Applicants presume all rejections raised under 35 U.S.C. §103 have been traversed.